

U.S. Patent Application No. 10/795,968  
Request for Reconsideration dated March 28, 2008  
Reply to Office Action of December 28, 2007

### **REMARKS/ARGUMENTS**

Reconsideration and continued examination of the above-identified application are respectfully requested.

Claims 36-58 and 62-65 are pending. No amendments to the claims have been made. The claims are shown as previously amended with updated status identifiers.

#### **Rejections of claims 36-43, 50-56, 58, 61, and 65 under 35 U.S.C. §102(b) – Chang or Chang as evidenced by He et al.**

At page 3 of the Office Action, the Examiner rejects claims 36-43, 50-56, 58, 61, and 65 for the same reasons as set forth in the previous Office Action dated July 19, 2007. With regard to claims 36 and 65 and the recitation of “agglomerated,” the Examiner relies upon col. 1, line 61 to col. 2, line 8, of Chang, as well as col. 4, lines 1-18, of Chang. The Examiner further, at page 4 of the Office Action, asserts that tantalum and niobium are known by those skilled in the art to be sufficiently similar to permit substitution of either metal and relies on He et al. to support this assertion. Further, the Examiner specifically relies upon Examples 1-6 of He et al. to assert that tantalum and niobium powders have been shown to have similar electrical properties and specifically refers to Tables 6 and 7 of He et al., as well as MPEP 2112, §I and §II. This rejection is respectfully traversed.

To avoid repeating arguments, the arguments in their entirety as set forth in the Amendment filed October 19, 2007 are incorporated in their entirety by reference herein with respect to the rejections relied upon by the Examiner. It is respectfully noted that these arguments still overcome each of the rejections and show the patentability of the present invention over the cited references.

In addition, with respect to the Examiner’s argument that Chang shows agglomerated

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powders, the Examiner's evidence for this assertion in Chang is based upon col. 1, line 61 to col. 2, line 8, as well as col. 4, lines 1-18 of Chang. However, these portions of Chang do not support the Examiner's position and, therefore, for these additional reasons, the claims are clearly patentable over Chang. In particular, col. 1, line 61 to col. 2, line 8, is the background section of Chang and specifically refers to a description of U.S. Patent No. 4,544,403 and, therefore, it is not the invention of Chang. Put another way, the very description relied upon by the Examiner for agglomerated powders is a different powder than the material described in Chang and for which the Examiner is basing this rejection upon. In essence, the Examiner is mixing and matching different inventions, whereas Chang clearly does not describe or suggest that the embodiments of U.S. Patent No. 4,544,403 can be incorporated into Chang's invention. Moreover, in this section of Chang, namely col. 1, line 61 to col. 2, line 8, U.S. Patent No. 4,544,403 strictly relates to tantalum-based materials and not at all to niobium. Therefore, this section would clearly teach that one can agglomerate certain types of tantalum-based materials, but not niobium and, therefore, further does not support the Examiner's anticipation rejection. *See* col. 1, line 61, which specifically refers to "tantalum base materials . . ." Furthermore, the Examiner's reliance on col. 4, lines 1-18, is not understood. This particular section of Chang nowhere mentions the agglomeration of powders, but relates to chemical reduction of tantalum-bearing salts or the crushing of tantalum-bearing ingots. In fact, this section does not even relate to niobium at all.

In addition, with respect to the Examiner's reliance on He et al., it is noted that He et al. is not prior art to the present invention. He et al. was granted September 7, 2004, and has a publication date (with respect to its application) of June 19, 2003, and has a U.S. filing date of September 30, 2002. However, the present invention, through several continuation applications, claims the benefit of U.S. Patent Application No. 09/310,322 filed May 12, 1999. Therefore, He et

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al. is not prior art to the present invention and cannot be relied upon to show any evidence of similar electrical properties since this evidence clearly was after the §120 filing date of the present application and, in fact, would support the patentability of the present invention since the present inventors were the ones that invented high capacitance niobium powders for purposes of anode formation. For this additional reason, this rejection should be withdrawn.

Finally, with respect to the Examiner's reliance on MPEP 2112, §I and §II, the relevant II section of the MPEP is set forth below:

## **II. INHERENT FEATURE NEED NOT BE RECOGNIZED AT THE TIME OF THE INVENTION**

There is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure *at the time of invention*, but only that the subject matter is in fact inherent in the prior art reference. *Schering Corp. v. Geneva Pharm. Inc.*, 339 F.3d 1373, 1377, 67 USPQ2d 1664, 1668 (Fed. Cir. 2003) (rejecting the contention that inherent anticipation requires recognition by a person of ordinary skill in the art before the critical date and allowing expert testimony with respect to post-critical date clinical trials to show inherency); see also *Toro Co. v. Deere & Co.*, 355 F.3d 1313, 1320, 69 USPQ2d 1584, 1590 (Fed. Cir. 2004) ("[T]he fact that a characteristic is a necessary feature or result of a prior-art embodiment (that is itself sufficiently described and enabled) is enough for inherent anticipation, even if that fact was unknown at the time of the prior invention."); *Abbott Labs v. Geneva Pharms., Inc.*, 182 F.3d 1315, 1319, 51 USPQ2d 1307, 1310 (Fed.Cir.1999) ("If a product that is offered for sale inherently possesses each of the limitations of the claims, then the invention is on sale, whether or not the parties to the transaction recognize that the product possesses the claimed characteristics."); *Atlas Powder Co. v. Ireco, Inc.*, 190 F.3d 1342, 1348-49 (Fed. Cir. 1999) ("Because 'sufficient aeration' was inherent in the prior art, it is irrelevant that the prior art did not recognize the key aspect of [the] invention.... An inherent structure, composition, or function is not necessarily known.")>; *SmithKline Beecham Corp. v. Apotex Corp.*, 403 F.3d 1331, 1343-44, 74 USPQ2d 1398, 1406-07 (Fed. Cir. 2005) (holding that a prior art patent to an anhydrous form of a compound "inherently" anticipated the claimed hemihydrate form of the compound because practicing the process in the prior art to manufacture the anhydrous compound "inherently results in at least trace amounts of" the claimed hemihydrate even if the prior art did not discuss or recognize the hemihydrate)<.

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As can be seen, an inherent disclosure in a prior art reference requires that the characteristic is a "necessary feature or result of a prior-art embodiment" that is sufficiently described and enabled. If one looks at Chang, the Examiner has not explained what embodiment of Chang has this inherent feature. As has been noted previous times before, all of the examples of Chang relate to tantalum powder, and Chang does not provide any particular example of niobium powders. Furthermore, the formation conditions and specifically the formation voltage used in Chang would destroy niobium metal as has been previously argued in the past and evidence has been provided to support this point. Therefore, there is no part of Chang which would permit the Examiner to take the position that the parameters set forth in the pending claims are a necessary feature or result of a prior-art embodiment in Chang. The Examiner is respectfully requested to identify a particular example in Chang that would permit this conclusion, since the applicants have been unable to find any such embodiment that would permit this conclusion to be reached.

Finally, though not prior art, the applicants do wish to point out that He et al. does not show tantalum and niobium powders having similar electrical properties since the Examiner has not taken into account the particular properties of the powders being used to form the anodes which have been tested in Tables 6 and 7. It is respectfully noted that Table 6 shows electrical properties of tantalum powders and Table 7 shows electrical properties of niobium powders; however, when one goes back into the patent to see the particular powder properties, one notes that in Examples 1, 2, and 3, the tantalum powders have a significantly different Scott bulk density, a significantly different particle size (FSS), and, most importantly, a very different BET surface area. For instance, the BET surface area of the tantalum powders is from 2.1 m<sup>2</sup>/g to 3.8 m<sup>2</sup>/g, whereas the BET surface area of the niobium powders that were tested had a BET surface area of 4.9 m<sup>2</sup>/g to 5.6 m<sup>2</sup>/g in Examples 6 and 5, and a BET surface area of 26.72 m<sup>2</sup>/g in Example 4. Also, the Green density

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and sintered density were dramatically different from the test conditions used for the tantalum powder as shown in Tables 6 and 7. Thus, the Examiner's assertion that "similar treatment conditions" were used is technically incorrect as shown above and no conclusions can be drawn from this reference.

Also, it is important to point out that Chang shows a BET surface area of no more than 0.6 m<sup>2</sup>/g (see col. 5, line 55), whereas He et al. used a BET surface area of 2 m<sup>2</sup>/g and above -- very different powders exist in He et al., and such data is irrelevant to the low surface area powder of Chang.

For these reasons, this rejection should be withdrawn.

**Rejection of claims 48, 49, 52, 57, and 62-64 under 35 U.S.C. §103(a) – Chang in view of He et al.**

At the bottom of page 4 and top of page 5 of the Office Action, the Examiner rejects claims 48, 49, 52, 57, and 62-64 for the same reasons set forth in the previous Office Action dated July 19, 2007, and relies on He et al. for the reasons set forth above in the rejection of claim 36. At page 5 of the Office Action, the Examiner does refer to a §102/§103 rejection of independent claim 36, however, it is respectfully noted that the Examiner only rejected claim 36 under 35 U.S.C. §102(b) at page 3 of the Office Action. This rejection is respectfully traversed.

As stated above, the arguments for the patentability of this subject matter in view of Chang as set forth in the Amendment filed October 19, 2007 are incorporated in its entirety by reference herein, as well as the comments above with respect to Chang filed with this response in the above §102 rejection. Further, as stated above, He et al. is not prior art to the claimed invention and, therefore, this rejection is improper and should be withdrawn for this reason alone.

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Also, the problems with He et al. as described above in the §102 rejection apply equally here. For these reasons, this rejection should be withdrawn.

**Rejection of claims 36-47, 49-58, and 62-65 under 35 U.S.C. §103(a) – WO 98/37248 in view of Chang and He et al.**

At page 5 of the Office Action, the Examiner rejects claims 36-47, 49-58, and 61-65 under 35 U.S.C. §103(a) as being unpatentable over WO 98/37248 in view of Chang and in view of He et al., wherein the Examiner is essentially relying on the reasons set forth in the previous Office Action dated July 19, 2007, and is relying on He et al. for the same reasons set forth in the above rejections. This rejection is respectfully traversed.

To avoid repeating arguments, the arguments in their entirety as set forth in the Amendment filed October 19, 2007 are incorporated in their entirety by reference herein with respect to the rejections relied upon by the Examiner. It is respectfully noted that these arguments still overcome each of the rejections and show the patentability of the present invention over the cited references.

As stated above, He et al. is not prior art to the claimed invention and for this reason alone, this rejection should be withdrawn.

Furthermore, the deficiencies and problems with the Examiner's reliance on He et al., as set forth above, apply equally here.

For these reasons, this rejection should be withdrawn.

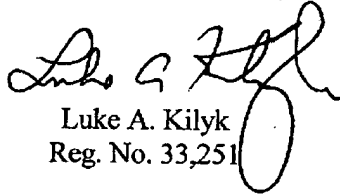
**CONCLUSION**

In view of the foregoing remarks, the applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

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If there are any fees due in connection with the filing of this response, please charge the fees to Deposit Account No. 03-0060. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such extension is requested and should also be charged to said Deposit Account.

Respectfully submitted,



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